



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,877	07/21/2006	Takeshi Ikemoto	016912-0216	8114

22428 7590 08/27/2008
FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

GOON, SCARLETT Y

ART UNIT	PAPER NUMBER
----------	--------------

1623

MAIL DATE	DELIVERY MODE
-----------	---------------

08/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/586,877	Applicant(s) IKEMOTO ET AL.	
	Examiner SCARLETT GOON	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>21 July 2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-4 are pending in the instant application.

Priority

This application is a National Stage entry of PCT/JP2005/000735 filed on 21 January 2005 and claims priority to Japan foreign application 2004-012764 filed on 21 January 2004. A certified copy of the foreign priority document in Japanese has been received. No English translation has been received.

Information Disclosure Statement

The information disclosure statement (IDS) dated 21 July 2006 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Accordingly, it has been placed in the application file and the information therein has been considered as to the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 1623

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over PG Pub No. US 2003/0054021 A1 by Dalko, *et al.* (PTO-892, Ref. A).

Dalko *et al.* teach a composition comprising 7-oxo-DHEA derivatives and a method for treating the adverse signs of aging of the skin by administration of the said composition (paragraphs 0003 and 0082). "Signs of the aging skin" include wrinkles and fine lines, loss of firmness and/or elasticity of the skin, cutaneous atrophy, a more irregular skin grain with presence of dilated pores, loss of radiance of the skin and/or pigmentary marks (paragraph 0083). The composition can further comprise 5 α -reductase inhibitors that can be selected from retinoids, sulfur and sulfur derivatives, zinc salts, selenium chloride, vitamin B6, a mixture of capryloyl glycine, sarcosine and an extract of *Cinnamomum zeylanicum*, an extract of *Laminaria saccharina*, an extract

Art Unit: 1623

of *Spiraea ulmaria*, plant extracts from various species, an extract of *Serenoa repens*, plant extracts of the genus *Silybum*, plant extracts containing sapogenins and extracts of *Eugenia caryophyllata* containing eugenol or eugenyl glucoside (paragraph 0115-0129). Compounds containing a 5α -reductase inhibitor is particularly suitable for treating seborrhoea and/or hirsutism and/or androgen-dependent alopecia (paragraph 0130). The 5α -reductase inhibitor can constitute from 0.01% to 5% of the total weight of the composition (paragraph 0130).

It is noted that the reference teaches 5α -reductase inhibitors as useful for treating seborrhoea and/or hirsutism and/or androgen-dependent alopecia, not as an antiwrinkle agent. However, as the 5α -reductase inhibitor, specifically eugenyl glucoside, is not used alone, but rather, in a composition useful for treating the adverse signs of aging of the skin, including wrinkles (paragraph 0082), the composition that includes eugenyl glucoside would necessarily also treat wrinkles. Thus, the presence of eugenyl glycoside in a composition for treating the adverse signs of aging of the skin would inherently also function as an antiwrinkle agent.

Moreover, the recitation of "antiwrinkle agent" is considered to be an "intended use" of the composition, and is therefore not given any patentable weight. Applicant is requested to note that the "intended use" of a composition will not further limit the claims drawn to a composition or product, so long as the prior art discloses the same composition comprising the same ingredients in an effective amount, as the instantly claimed. See, e.g., *Ex parte Masham*, 2 USPQ2d 1647 (1987) and *In re Hack* 114, USPQ 161.

Art Unit: 1623

Therefore, although Dalko *et al.* does not exemplify an antiwrinkle composition comprising a eugenyl glycoside, the reference does provide sufficient disclosure as to what various components can be included into an antiwrinkle composition. As such, it would have been *prima facie* obvious for one of ordinary skill in the art to prepare an antiwrinkle composition comprising eugenyl glucoside.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCARLETT GOON whose telephone number is 571-270-5241. The examiner can normally be reached on Mon - Thu 7:00 am - 4 pm and every other Fri 7:00 am - 12 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shaojia Anna Jiang, Ph.D./
Supervisory Patent Examiner, Art Unit 1623

/SCARLETT GOON/
Examiner
Art Unit 1623